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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,394	07/03/2003	Matthias Gonschor	GK-ZEI-3195 / 500343.2020	4459
7590	11/03/2004		EXAMINER PRITCHETT, JOSHUA L	
REED SMITH LLP 599 Lexington Avenue New York, NY 10022-7650			ART UNIT 2872	PAPER NUMBER

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,394

Applicant(s)

GONSCHOR ET AL.

Examiner

Joshua L Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed January 2004 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered. The applicant is requested to supply a copy of the form PTO-1449 with the list of the references with the response to this action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim states, "the mechanical unit is constructed as a slide." The examiner does not understand what the claim means. The invention based on the claim language for claim 1 is for a microscope, but a microscope slide does not have illumination devices. A microscope slide is illuminated with light from illumination devices. Another possible interpretation is that the applicant wished to indicate that the mechanical unit itself or some portion of the mechanical

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unit is capable of sliding in some direction. The claim will not be examined further because no definite determination of the claim limitation can be made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki (US 2002/0181096).

Regarding claim 1, Sasaki discloses a device for coupling in light for illumination a preparation in the beam path of a microscope (Fig. 1) which has an objective (14) and a tube lens (13) and a reflection light illumination device (Fig. 1) which comprises a light source (3) and a condenser (12), wherein the condenser images the light source in the field diaphragm plane and in so doing defines an optical axis (Fig. 1) comprising an at least partially reflecting element (10) being provided in the vicinity of the field diaphragm plane and reflecting light from a second light source (2) into the beam path at a slight angle relative to the optical axis (Fig. 1).

Regarding claim 2, Sasaki discloses the second light source is a laser (Fig. 1).

Regarding claim 3, Sasaki discloses wherein the angle at which the light of the second light source is reflected into the beam path is adjustable (para. 0021). Sasaki states that the partially reflecting element (10) is rotatable therefore the partially reflecting element is capable of adjusting the angle of light reflected from the face of the partially reflecting element.

Regarding claim 4, Sasaki discloses the partially reflecting element reflects the light of the second light source into the beam path parallel to the optical axis (Fig. 1).

Regarding claim 5, Sasaki discloses the partially reflecting element is arranged at an angle of 45° to the optical axis (Fig. 1).

Regarding claim 6, Sasaki discloses a light conducting fiber (7) is provided which is held in such a way that the partially reflecting element is acted upon by the light of the second light source by an optical imaging system (Fig. 1).

Regarding claim 9, Sasaki discloses the optical imaging system can be focused (Fig. 1). Fig. 1 shows that the objective (14) focuses the light onto the object (15).

Regarding claim 10, Sasaki discloses the partially reflecting element, the holder of the light conducting fiber and the optical imaging system are combined in a mechanical unit (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki in view of Hasegawa (US 6,792,138).

Regarding claim 7, Sasaki teaches the invention as claimed but lacks reference to the use of an inclination adjuster for the light conducting fiber. Hasegawa teaches the use of an inclination adjuster for a light conducting fiber in a microscope (col. 5 lines 57-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Sasaki invention include the inclination adjuster of Hasegawa for the purpose of scanning the light from the light source across the objective.

Regarding claim 8, Sasaki teaches the holder of the light conducting fiber has a base inclination relative to the optical axis (Fig. 1).


Conclusion

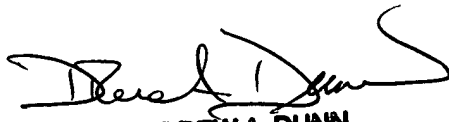
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 


DREW A. DUNN
SUPERVISORY PATENT EXAMINER